in the art from a reading of the claim and the specification, especially in light of the accepted rule that different words in patent claims are presumed to have different meanings.

For this reason, and as claim 21 is an independent claim upon which all other claims depend, Applicants respectfully ask that the Examiner reconsider and withdraw the rejection of the indicated claims.

Rejection Pursuant to 35 USC §102

Claims 21-25, 33 and 39 were rejected pursuant to 35 USC §102(a) as allegedly anticipated by Klein et al., 271 *J. Biol. Chem.* 22692 (September 13, 1996). Applicants respectfully traverse this rejection for the following reasons.

Klein et al. is not prior art to the present claims. The present patent application claims priority to US patent application 08/613,863, filed March 11, 1996, which became US Patent No. 5,776,699. The '863 application contained disclosure supporting the present claims (i.e., a method for identifying inverse agonists with two peptides via a transactivation assay; see e.g., columns 95-99 of the '699 patent); thus the filing date of the '863 application is at least the latest date of reduction to practice of the presently claimed invention. As such, Klein et al. is *prima facie* not a printed publication which described the claimed invention before the invention thereof by the present Applicants, as required by 35 USC §102(a).

Rejection Pursuant to 35 USC §103

Claims 21-25, 33 and 39 were rejected as allegedly obvious over US Patent 5,776,699, which issued from Serial No. 08/613,863, filed March 11, 1996, the grandparent of this patent application. As a chain of priority from this patent application to the '863 application has been properly established, the '699 patent cannot be used as prior art against the present patent application. 35 USC §120 states (and has consistently stated both prior to and after the AIPA amendments):

> An application for patent for an invention disclosed in the manner provided by the first paragraph of Section 112 of this title in an application previously filed in the United States . . . which is filed by an inventor or inventors named in the previous filed application shall have the same effect, as to such invention, as though filed on the date of the prior application . . . .

As stated above, the '699 patent describes the currently claimed invention. Thus, the '699 patent is not prior art against the present patent application, which, as to the invention presently claimed, shall be treated as

though filed no later than March 11, 1996. Applicants therefore respectfully request that the Examiner withdraw this rejection.

Obviousness-Type Double Patenting Rejection

With this communication Applicants are also forwarding a Terminal Disclaimer disclaiming that portion of the term of the present application which would extend beyond that of U.S. Patent 5,776,699. Thus, this rejection is now thought to be moot.

CONCLUSION

For the above-indicated reasons, the present application is thought to be in condition for allowance, and Applicants respectfully ask that the Examiner issue a Notice to that effect. If there is any fee due in connection with this Communication, please use Deposit Account 01-0885.

Respectfully submitted,

Dated: 10/10/02

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